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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,827	01/03/2002	Gary P. Morrison	TI-31373	4496
23494	7590 08/11/2004		EXAMINER	
TEXAS INSTRUMENTS INCORPORATED P O BOX 655474, M/S 3999			MITCHELL, JAMES M	
DALLAS, TX 75265			ART UNIT	PAPER NUMBER
			2813	_

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)			
Advison, Action	10/034,827	MORRISON ET AL.			
Advisory Action	Examiner	Art Unit			
	James M. Mitchell	2827			
The MAILING DATE of this communication app	ears on the cover sheet with the c	correspondence add	ress		
THE REPLY FILED 12 July 2004 FAILS TO PLACE THE Therefore, further action by the applicant is required to a final rejection under 37 CFR 1.113 may only be either: (condition for allowance; (2) a timely filed Notice of Appel Examination (RCE) in compliance with 37 CFR 1.114.	avoid abandonment of this appliced a timely filed amendment whice all (with appeal fee); or (3) a time	cation. A proper rep ch places the applic	oly to a cation in		
PERIOD FOR RI	EPLY [check either a) or b)]				
a) The period for reply expiresmonths from the mailing b) The period for reply expires on: (1) the mailing date of this Ad event, however, will the statutory period for reply expire later the ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS 706.07(f).	visory Action, or (2) the date set forth in the nan SIX MONTHS from the mailing date o	f the final rejection.			
Extensions of time may be obtained under 37 CFR 1.136(a). The data been filed is the date for purposes of determining the period of exter 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortene (b) above, if checked. Any reply received by the Office later than three meanned patent term adjustment. See 37 CFR 1.704(b).	nsion and the corresponding amount of the d statutory period for reply originally set in	e fee. The appropriate ext the final Office action; or	ension fee under (2) as set forth in		
1. A Notice of Appeal was filed on Appellant 37 CFR 1.192(a), or any extension thereof (37 CF					
2. The proposed amendment(s) will not be entered to	pecause:				
(a) they raise new issues that would require furth	ner consideration and/or search ((see NOTE below);			
(b) ☐ they raise the issue of new matter (see Note below);					
(c) they are not deemed to place the application issues for appeal; and/or	in better form for appeal by mat	erially reducing or s	simplifying the		
(d) they present additional claims without cance	eling a corresponding number of	finally rejected clair	ns.		
Applicant's reply has overcome the following reje	ction(s):				
4. Newly proposed or amended claim(s) would canceling the non-allowable claim(s). 4. would be canceling the non-allowable claim(s).	· · · ——	separate, timely filed	d amendment		
5. ☑ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for application in condition for allowance because: S		sidered but does NC	OT place the		
6. The affidavit or exhibit will NOT be considered be raised by the Examiner in the final rejection.	ecause it is not directed SOLELY	to issues which we	re newly		
7. For purposes of Appeal, the proposed amendmen explanation of how the new or amended claims we			and an		
The status of the claim(s) is (or will be) as follows					
Claim(s) allowed:					
Claim(s) objected to:					
Claim(s) rejected: <u>2,4-10,12,15,17,18 and 23</u> .	•				
Claim(s) withdrawn from consideration:					
8. The drawing correction filed on is a) ap	proved or b) disapproved by	the Examiner.	^		
9. Note the attached Information Disclosure Stateme			11		
10. Other:		1 sandte	Lunch		

U.S. Patent and Trademark Office PTOL-303 (Rev. 11-03)

Continuation of 5. does NOT place the application in condition for allowance because: applicant has not effectively established an earlier filling date to overcome the cited prior art. M.P.E.P section 715.07 provides three ways pursuant to 37 CFR 1.131(b) to effectuate prior invention of the claimed subject matter. Since a 1.131 declaration is explicitly provided as a basis that evidence be submitted to establish prior inventorship, filing of a 1.132 declaration is ineffective, because it is used as evidence submitted to traverse the rejection or objection on a basis "otherwise provided for." Assuming that the declaration was appropriately filed under a 1.131 declaration or affidavit, it would still be ineffective since there would be no facts of record sufficient to show either (A) reduction to practice of the invention prior to the effective date of the reference; or B) conception of the invention prior to the effective date of the reference date to a subsequent (actual) reduction to practice; or (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the effective date of the reference coupled with due diligence from prior to the effective date of the application (constructive reduction to practice).

While applicant did submit a disclosure form, a date on its 2nd page does not appear to corroborate prior invention of the claimed subject matter. The date appears to indicate a submission to the "TI Patent DEPT" of either 2002 or 2003. Furthermore applicant's argument that a provisional application is proof that subject application "was ready for patenting" was an attempt to satisfy standards set forth in PFAFF v. Wells Electronics. Besides applicant's admission that priority was not granted under provisional application #60/258,525 (1st page) and that being "ready for patenting" is not the standard to enable applicant to swear behend a reference, PFAFF v. Wells Electronics is nonanalagous in that it dealt with the issue of infringement not this application's issue of the requirements needed to enable applicant to swear behind a reference.